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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,967	04/24/2000	MATTI KORPELA	2328-117	8859

7590 01/10/2002

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EXAMINER
SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
1655	15

DATE MAILED: 01/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/529,967	Applicant(s) KORPELA ET AL.	
	Examiner Bradley L. Sisson	Art Unit 1655	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 December 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

B. L. Sisson

Bradley L. Sisson
Primary Examiner
Art Unit: 1655

Continuation of 2. NOTE: The proposed amendment under Rule 1.116 seeks to add the work "recombinant" immediately before "prokaryotic cells." Given that the "prokaryotic cells" have already been defined as having a DNA vector that comprises "a nucleotide sequence encoding a light producing enzyme under transcriptional control of a tetracycline repressor and a tetracycline promoter," the "prokaryotic cells" would, by default, be recombinant. Futhermore, the aspect of a cell being "recombinant" would apply to both naturally-ocurring cells and cells modified by the hand of man as both undergo recombination- one form naturally-ocurring and one not. Accordingly, the propsoed amendment has not ben found to materially reduce or simplify the issues should applicant file an appeal.

Continuation of 5. does NOT place the application in condition for allowance because: The response of applicant received 28 December 2001 refers to the Rule 132 Declaration of Matti Karp, co-inventor of the subject application. It is noted with particularity that the declaration is directed to the rejection of claims under 35 USC 112, first paragraph, and that the declaration was submitted AFTER the mailing of the Final Office Action of 28 August 2001. Declarations submitted after final are limited to new issues that were raised in the Final Office Action. A review of the non-final Office Action of 23 February 2001 clearly shows that the claims were rejected under 35 USC 112, first paragraph. Accordingly, the declaration is not considered to have been timely filed. In view of such a finding, the declaration has not been considered.

To the extent that applicant presents argument separate of the declaration, said arguments have not been found to be persuasive towards the withdrawal of the rejections. At page 3 of the response argument is presented that the amendment to the claims would result in the claimed invention having unity of invention and that as such the claims should be rejoined and examined. This argument has not been found to be persuasive towards the entry of the rejection as applicant is seemingly trying to perpetuate examination of an application after prosecution on the merits has been closed. Applicant is directed to page 2, last paragraph, of the Office action of 28 August 2001 wherein is stated: "A complete response to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP 821.01." "Other appropriate action" is the filing of an appeal, not reopening of prosecution and rejoinder of claims. Applicant's response has not been found to contain either required action.

Agreement is reached in that enablement is "considered in light of the knowledge in the art at the time of the invention" (applicant's response at page 3, last paragraph). It is also noted that the claims are to be read as broadly as reasonably possible. Claim 1, be it the pending version or the proposed version of the December 28th response, is considered to encompass the use of virtually any prokaryotic cell. As noted at page 4 of the prior Office action, claim 10 specifically recites types of samples that are to be tested. Such samples include "fish, meat, infant formula, eggs, honey, vegetables, serum, plasma, whole blood or the like." While argument is presented at page 5 of applicant's response, the argument is predicated on the declaration of co-inventor Dr. M. Karp, supra. The articles referenced do not support the position that the level of skill was such that infant formula, vegetables, or the like could be readily tested.

At page 4 of the prior Office action attention was directed to the conditions under which the claimed method has been found to be enabling. Inspection of the application finds attention being directed to the concentration of magnesium ions that may be present and how that impacts the assay. The claimed method, in contrast, places no limit on the assay sensitivities or on the amount of metallic ions that are present. In the absence of limitations in the claims, the claims have been interpreted as encompassing any number of conditions, including those that applicant has acknowledged are quite problematic. In view of such disclosures, applicant's argument of the specification being fully enabling for all claims presently before the Office has not been found to be persuasive. Acknowledgement is made of applicant's agreement that the claims may well encompass the breadth identified by the Office; response at page 9, last paragraph. Agreement is reached where applicant states that broad breadth of scope "in and of itself does not render the claims enabled by the specification."

For the above reasons, and in the absence of convincing evidence to the contrary, the rejections are maintained.